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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,590	08/14/2001	John R. Reynolds	41530/28295	3647
21888	7590	04/20/2004	EXAMINER	
THOMPSON COBURN, LLP ONE US BANK PLAZA SUITE 3500 ST LOUIS, MO 63101			DESANTO, MATTHEW F	
			ART UNIT	PAPER NUMBER
			3763	

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/929,590

Applicant(s)

REYNOLDS ET AL.

Examiner

Matthew F DeSanto

Art Unit

3763

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): Gresser et al. (USPN 5,429,822).
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 54-63

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☒ Other: See Continuation Sheet

Continuation of 5. does NOT place the application in condition for allowance because: With regards to the 103 Rejection in view of Miller et al., the examiner disagrees with the applicant because Miller et al. teaches an apparatus that can perform the same function as the claimed invention, with regards to releasing the medication either gradually or in bursts, (Column 2, lines 50-68, Column 6, lines 59-65) and used the obvious rejection to show that it would be obvious to modify the prior art to incorporate more than one release pad because this would be a duplication of parts, which has been found by the courts to be an obvious modification. (because it is well known that duplicating the components of a prior ad device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960), and therefore, a mere modification that would have been obvious). Since claim 54 is an apparatus claim the examiner holds the opinion that it would be capable of performing that function and work in the manner that is claimed in the application. Since Miller et al. would be controlled by a remote station, the person controlling this station would control when and how the release pads were released. Thus the examiner believes that Miller et al. would perform the method step of claim 61 as well.

With regards to Pickett et al. the examiner disagrees with Pickett et al. because Pickett et al. discloses the same structure that performs the same function. Pickett et al. discloses an electrode that has a compound that releases the medicament by electrical means and wherein the electrode has the ability to control the amount and duration of the drug to be delivered to the patient. (Column 1, line 61-Column 2, line 5; Column 2, lines 45-53 and Column 6, lines 44-50).

The double patenting rejection is a provisionally rejection and it depends on what the claims are that get allowed in the other case, as well as the claims in this application. Therefore, the examiner holds this rejection until case 09/929197 is allowed and the claims can be compared.

Continuation of 10. Other: The examiner found other references that resemble the applicant's invention and is disclosing the reference number to expedite the prosecution. (USPN 6,669,683 & USPN 6,317,630).

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4/7/04

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